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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,981

09/22/2006

Shigeru Miyamoto

723-1985

3405

27562

7590

08/24/2010

NIXON & VANDERHYE, P.C.

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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

08/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/593,981	Applicant(s) MIYAMOTO ET AL.	
	Examiner Pierre E. Elisca	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/22/09, 5/29/07, 9/22/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Application No. 10/593,981 filed on 09/22/2006.
2. Claims 1, 3, and 5-26 are currently pending and have been examined.

Information Disclosure Statement

3. IDS filed on 11/22/2009, 05/29/2007, and 09/22/2006 are considered.

Claim Objections

4. Claims are objected to because of the following informalities: The claims recite the word (or pronoun) “it”. Applicant is also advised to remove it. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1, 3, 7, 10, 11, 12, 13, 15, 19, 20, 21, 22, 23, 24, 25, and 26 and all dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

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For example, in claims 1, 3, 7, 10, 11, 12, 13, 15, 19, 20, 21, 22, 23, 24, 25, and 26, Applicant has failed to clearly link and associate the **“means for/to phrase and step for”** to any corresponding structure. To avoid additional 35 U.S.C. 112, 2nd paragraph rejections, the Examiner recommends Applicant to review his claims.

It appears the Applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in claims 1, 3, 7, 10, 11, 12, 13, 15, 19, 20, 21, 22, 23, 24, 25, and 26 by using “means-plus-function” language, such as “means for storing, means for determining, means for switching, means for performing, means for instructing, means for detecting, step for detecting, step for switching ...”, and etc. in the claims.

In order to successfully invoke the sixth paragraph, a three-prong test must be met. Namely, (1) the claim must use means-plus-function or step-plus-function language, (2) the claim itself must not provide structural limitations to the means-plus-function, or step-plus-function language, and (3) the specification must recite explicit physical structural limitations for the means-plus-function, or step-plus-function language in the claim. While the above claims pass the first two prongs of the three prong test, they do not pass the third prong.

There is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function or step-plus-function limitations in the claim. The only “structure” for performing the functions in the above claims appears to be computer program modules (i.e virtual structure, not physical structure). Therefore, 35 U.S.C. 112, 6th paragraph has not been successfully invoked. The Examiner will

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consider the means or steps to perform the claimed functions as any means or steps, physical or virtual, which can perform the function.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, Applicant is required to amend the claim so that the phrase “means for” is clearly not modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does not wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, Applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” and “step for”).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00. Hotelier.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571 272 4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pierre E. Elisca/
Primary Examiner, Art Unit 3714